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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/528,773

03/23/2005

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EXAMINER

UNDERDAHL, THANE E

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/528,773</p> | <p>Applicant(s) YONEDA ET AL.</p> | |
| | <p>Examiner THANE UNDERDAHL</p> | <p>Art Unit 1651</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10.
Claim(s) withdrawn from consideration: 11-20.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached page.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Irene Marx/
Primary Examiner, Art Unit 1651

Response to Applicant's Arguments

In the response submitted by the Applicant the 35 U.S.C § 102 (b) rejection of claims 1, 2, 5, 8 and 9 based on Ohno #1 is withdrawn in light of Applicant's argument. Also the 35 U.S.C § 102(b) rejection claims 1, 2, 3, 5, 6, 7, 8 and 9 as also being anticipated by Ohno #1 is withdrawn in view of Ohno #1.

However the alternative 35 U.S.C § 103 rejection of claims 1, 2, 3, 5, 6, 7, 8 and 9 over Ohno #1 in view of Ohno #2 and Ohno #3 remains as the Applicant's argument was not persuasive for the following reasons.

The Applicant argues that , the method of Ohno #1 is drawn to solid-state fermentation using solid medium and not a liquid medium as required by the claims.

The term "liquid medium" when read in light of the claims and specification is at least ambiguous. Claim 1 reads "a liquid medium containing 2% mass or more of soybean powder or its extract". The claim does not provide an upper limit to the amount of soybean powder or extract. Such a limitation does not clearly specify the amount of soybean powder or extract added so that the process remains a "liquid fermentation" (Applicant's Response, page 4, 3rd paragraph). The reference does indeed teach a soybean extract that contains liquid and contains "greater than 2% or more of soybean powder or its extract".

The Applicant argues that okara is not a soybean extract.

Once again the term "soybean extract" is ambiguous. The Applicant does not necessarily define extract and taken in broad use terms can include any portion of the soybean that can be fractionated. Given that okara is indeed the fraction of soybean that contains extractable materials such as fat, starch and fiber it is understood by the broad terms of one of ordinary skill in the art as an extract.

Regarding the surfactin production it is noted that the B. subtilis NB22 used by Ohno #1 produces Iturin A (Ohno #1 Abstract) but does not produce detectable amounts of surfactin and the Applicant has not shown otherwise.

Furthermore the Applicant fails to recognize that all of the claims except 6 and 7 are directed to any Bacillus strain or the genus B. subtilis. Therefore the Applicant has not shown that it is the culture conditions rather than the specific strain used or combination of strains and particular conditions that produce Iturin A or its unspecified homologs commensurate with the scope of the independent claim. Therefore while the Applicant has overcome the anticipatory rejection over Ohno #1 the claims remain rejected as being obvious over Ohno#1..